Supreme Court of the United States

OCTOBER TERM 1945

No. 500

ALBA TRADING CO. INC.,

Petitioner
(Defendant below),

against

MUSHER FOUNDATION, INC.,

Respondent
(Plaintiff below).

PETITION OF ALBA TRADING CO. INC. AND BRIEF IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

JOSEPH JOFFE,
Counsel for Petitioner,
141 Broadway,
New York 6, N. Y.

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STATUTES

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Petition of Alba Trading Co. Inc.

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATED JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

The petition of ALBA TRADING CO. INC., a corporation, respectfully shows to this Court as follows:

I. That this is a petition to review a final decision and judgment in a patent suit, of the United States Circuit Court of Appeals for the Second Circuit, entered July 18, 1945, which judgment reversed a judgment of the District Court of the United States for the Southern District of New York in favor of the defendant and petitioner herein. The District Court decided that United States Patent No. 2,221,404 relating to a substitute for olive oil, and having two claims—one for method and the other for product—was not infringed as to method, and

that the product claim was invalid because of indefiniteness, and dismissed the suit. The Circuit Court held the product claim valid and found that defendant infringed the method claim. The opinion of the Circuit Court of Appeals is found at pages 170 to 176 of the Record. The opinion of the District Court is found at pages 159 to 162 of the Record.

II. This Court has jurisdiction to review the judgment under § 347 of the United States Code (Sec. 240 of Judicial Code) and § 350 of the United States Code.

III. The question presented is the validity of United States Patent No. 2,221,404 granted to respondent on November 12, 1940, upon the application of Sidney Musher, for a process of making a food product of general use, to wit: an imitation olive oil, by infusing a "glyceride" oil—such as cottonseed oil or corn oil—with a "macerated" paste of specially prepared olives (Record p. 170, fol. 171). The process of infusion has been used for generations, as, for instance, in the brewing of tea or coffee, and if the respondent's patent is sustained the respondent will take away from the public domain the right to infuse corn oil or similar oils with any olives, and prevent the general public from enjoying any imitation olive oils, no matter how infused, without a license from the respondent.

IV. A reading of the opinion of the Circuit Court of Appeals makes it apparent that the Court committed error in assuming that the process carried out by the petitioner was equivalent to that of the respondent.

The Court also departed from numerous decisions of this Court and other circuit courts of appeal, in declaring that an inventor who voluntarily abandons certain claims before the issuance of a patent, does not thereby dedicate them to the public. (In the case at bar claims

providing for the elimination of heat as an element were abandoned.) (Record pp. 166 and 173, fol. 174.) Such a ruling is in direct contradiction to the law laid down in:

Schreiber & Co. v. *Cleveland Trust Co.*, 311 U. S. 211, 220 (1940);
Altoona Publix Theatres, Inc. v. *American Tri-Ergon Corporation*, 294 U. S. 477, 492 (1935);
Leggett v. *Avery*, 100 U. S. 256, 259 (1875).

This decision of the Circuit Court of Appeals is contrary to the law laid down by the Circuit Court of Appeals for the Fifth Circuit in

Dry Hand Mop Co. v. *Squeez-Ezy Mop Co. Inc.*, 17 Fed. (2d) 465, 466 (1927)

where the Court said:

> "The voluntary relinquishment of an element gives the public the right to use it in substitution of any claim of equivalency."

To sustain the process claim it was necessary for the Circuit Court to take the position that "room temperature" and "more time" are equivalents of "a short time" and a "slightly elevated temperature", without any proof or explanation thereof (Record p. 173, fol. 174).

The Circuit Court of Appeals overruled the District Court's finding that the product claim does not comply with the statutory requirements of Revised Statutes Sec. 4888 (35 U. S. C. Par. 33). A reading of the product claim of the patent in question demonstrates without argument that the claim is invalid on its face, if the decisions of this Court in

General Electric Co. v. *Wabash Appliance Corp.*, 304 U. S. 364, 368 (1937);

and

United Carbon Co. v. *Binney & Smith Company*, 317 U. S. 228, 232 (1942),

are to be followed.

The Circuit Court of Appeals in sustaining the product claim failed to consider that the product of the petitioner is different from that of the patentee (Record, p. 157, Deft's. Exhibit D). Finally we submit that the Circuit Court has entirely overlooked the fact that the patent in question was granted for an infusion process of specially prepared olives as described in said patent (Record, p. 147), whereas the petitioner uses a common variety of olives readily purchased in the open market, known long before the disclosure made by the inventor (Record, p. 120, fol. 358).

V. The reasons relied on for the allowance of the writ are:

(a) The claim for product is invalid on its face under the decisions of this Court in

General Electric Co. v. *Wabash Co.*, 304 U. S. 364, 368 (1937);
United Carbon Co. v. *Binney & Smith Co.*, 317 U. S. 228 (1942).

(b) The Circuit Court of Appeals enlarged the scope of the patent as defined by the process claim, by resort to the doctrine of equivalents, while Musher, the patentee, by withdrawing his other claims in the Patent Office (See Record pp. 166 and 173, fol. 174) has surrendered said claims so far as they would otherwise read upon the alleged infringement, to wit, elimination of heat. (See Opinion, Record, p. 173, fol. 174).

Exhibit Supply Co. v. *Ace Patents Corp.*, 315 U. S. 126 (1942).

(c) The Circuit Court of Appeals misinterpreted the decision of this Court in *General Electric Co.* v. *Wabash Appliance Co.*, 304 U. S. 364 (1937), and failed to follow the decision of this Court in *Schreiber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211 (1940).

(d) The decision and judgment of the Circuit Court of Appeals is contrary to the adjudications of this Court in

General Electric Co. v. *Wabash Co.*, 304 U. S. 364, 371-372 (1937);
United Carbon Co. v. *Binney & Smith Co.*, 317 U. S. 228 (1942);
Exhibit Supply Co. v. *Ace Patent Corp.*, 315 U. S. 126 (1942);
Schreiber-Schroth Co. v. *Cleveland Trust Co.*, 311 U. S. 211 (1940);
Holland Furniture Co. v. *Perkins Glue Co.*, 277 U. S. 245, 256-258.

(e) The importance of the questions adjudicated by the Circuit Court of Appeals to the administration of the patent laws,

United Carbon Co. et al v. *Binney & Smith Co.*, 317 U. S. 228, 229, 1942);
Sola Electric Co. v. *Jefferson Co.*, 317 U. S. 173, 175.

and the restriction the decision will impose upon the distribution of food to which the public is entitled without reservation.

VI. We most earnestly urge that the statement of law in the opinion of the Circuit Court of Appeals in this case should be corrected lest there be established thereby a precedent which would change the long recognized rules of law as to disclosures under Section 4888 of the Revised

Statutes of the United States (35 U. S. C. § 33), and also that the unprecedented qualification as to the law of disclaimers as affecting patents, be declared erroneous and one not intended by the statute.

Both of these matters are of great importance to the administration of the patent laws, and the Circuit Court rulings are contrary to the public interest. The judgment of the Circuit Court of Appeals in the case at bar deprives the public of the right to enjoy foods known and used long before the granting of the patent.

WHEREFORE, your petitioner prays:

(a) That a writ of certiorari issue out of and under the seal of this Court directed to the United States Circuit Court of Appeals for the Second Circuit commanding the said Court to certify and send to this Court on a day to be designated in said writ, a full and certified transcript of the record and of proceedings in the Circuit Court of Appeals for the Second Circuit in a suit entitled "Musher Foundation, Inc., Plaintiff-Appellant, against Alba Trading Co. Inc., Defendant-Appellee, Civil No. 15-395," to the end that the said suit may be reviewed and determined by this Court, as provided in United States Code Title 28, Judicial Code and Judiciary, Section 347, and that the decision and judgment of the Circuit Court of Appeals for the Second Circuit in the said suit may be reversed by this Honorable Court.

(b) That your petitioner may have such other and further relief as to this Court may seem proper and just and in conformity with the laws of the United States.

(c) And your petitioner will ever pray, etc.

ALBA TRADING CO. INC.
By Julius Mario Russo,
General Manager.

JOSEPH JOFFE,
of Counsel for Petitioner.

STATE OF NEW YORK
COUNTY OF NEW YORK } ss.:

JULIUS MARIO RUSSO being duly sworn, deposes and says that he is the General Manager of ALBA TRADING CO. INC. herein; that he has read the foregoing petition and knows the contents thereof, and that the same is true to his own knowledge, except as to the matters herein stated to be alleged upon information and belief, and as to those matters he believes it to be true.

Deponent further says that the reason this verification is made by deponent and not by ALBA TRADING CO. INC. is because the said ALBA TRADING CO. INC. is a corporation, and deponent an officer thereof, to wit, its General Manager.

JULIUS MARIO RUSSO.

Sworn to before me this
9th day of October, 1945.

ORRIE L. SHURE,
Notary Public,
Kings County,
Cert. filed N. Y. County.
Commission expires March 30, 1945.
(NOTARIAL SEAL)

I hereby certify that I have examined the foregoing petition, that in my opinion it is well founded and entitled to the favorable consideration of the Court, and that it is not filed for the purpose of delay.

JOSEPH JOFFE,
Counsel for Petitioner.